**IN THE UNITED STATES DISTRICT COURT**
**FOR THE EASTERN DISTRICT OF TEXAS**
**MARSHALL DIVISION**

**BARKAN WIRELESS IP HOLDINGS, L.P.,**

**Plaintiff,**

**v.**

**T-MOBILE US, INC., T-MOBILE USA, INC., and NOKIA OF AMERICA CORPORATION,**

**Defendants.**

**Civil Action No. 2:21-cv-00034-JRG**

**JURY TRIAL DEMANDED**

## JOINT MOTION FOR ENTRY OF A PARTIALLY DISPUTED DISCOVERY ORDER

Plaintiff Barkan Wireless IP Holdings, L.P., ("Barkan") and Defendants T-Mobile US, Inc., T-Mobile USA, Inc., and Nokia of America Corporation (collectively, "Defendants") hereby move the Court for entry of a Partially Disputed Discovery Order.

The parties have met and conferred and agree on all provisions of the proposed Discovery Order for this case with the exception of the single disputed provision, Paragraph 12(d). The parties' competing versions of this provision are shown in the table below, with the differences between the two versions highlighted.

| Plaintiff's Version of Paragraph 12(d) | Defendants' Version of Paragraph 12(d) |
|---|---|
| d. Privilege Log Limitations. The Parties agree that materials withheld from discovery on grounds of privilege or work product that were created or dated after the date on which the party retained outside counsel in connection with the above-styled action or after February 2, 2021, whichever is earlier, are exempt from privilege log disclosure requirements. | d. Privilege Log Limitations. The Parties agree that materials withheld from discovery on grounds of privilege or work product that were created or dated after February 2, 2021 are exempt from privilege log disclosure requirements. |

## I. Plaintiff's Position

Plaintiff Barkan respectfully requests that the Court enter its privilege-log provision. The provision Plaintiff proposes is the same provision that Plaintiff and counsel for Sprint (now counsel for Defendant T-Mobile) agreed upon in prior litigation in this District, *Barkan Wireless IP Holdings v. Sprint*, 2:19-cv-00336, Dkt. 59 ¶ 12(d). It provides that parties need not log materials withheld as privileged or work product created either (a) after this action was filed on February 2, 2021 or (b) after a party retained counsel in connection with the action.

*First*, Defendants' proposal—that communications after litigation counsel was retained are *not* exempt—only benefits Defendants and only harms Plaintiff. Defendants' counsel benefits either way, because they were retained *after* the February 2, 2021 Complaint. Plaintiffs' counsel, however, was retained in October of 2017, and represented Plaintiff in prior cases in this District involving the same patents and similar accused products, *Barkan Wireless IP Holdings v. Samsung and Verizon*, 2:18-cv-00028 and *Barkan Wireless IP Holdings v. Sprint and CommScope*, 2:19-cv-00336. Requiring Plaintiff to log communications with counsel over years of litigation is extremely onerous, and includes in the logging obligation what parties agree is undisputedly privileged: communications with outside counsel created after being retained for litigation.

*Second*, that Plaintiff's proposal is fair is demonstrated by the fact that Defendants did not originally object to it. T-Mobile originally requested that materials from certain prior litigations be exempted, and Plaintiff agreed. Defendants reversed course in favor of burdening Plaintiff only in the final hours before the Discovery Order was due, requiring the parties to request an extension.

*Third*, Plaintiff's privileged communications after retention are irrelevant. The only issue Defendants speculated such materials may address is when Plaintiff learned of the accused

products. That can be discovered via non-privileged communications, and regardless, is not relevant, as the laches defense no longer exists. *SCA Hygiene*, 137 S. Ct. 954 (2017).

## II. Defendants' Position

Defendants' proposal provides a simple and easily understood cut-off date for materials that do not need to be logged—February 2, 2021, the date that the Complaint in this case was filed. Defendants' proposal is standard for Discovery Orders in this District.[1] In contrast, Barkan's proposal is ambiguous and unclear, not requiring Barkan to log privileged materials after "***the date on which the party retained outside counsel***" (emphasis added). Barkan has recently litigated the patents-in-suit in two other litigations[2], and it provides no insight into when, in its opinion, it "retained outside counsel" in "***connection***" with this case. Thus, it appears that Barkan seeks to withhold logging of all relevant communications associated with the patents-in-suit or defendant T-Mobile from any prior case (potentially dating back to 2016), even though communications in those cases took place years before the Complaint in this case was filed.

Defendants are entitled to discovery of relevant communications, which includes Barkan having to log privileged materials. *See* FED. R. CIV. P. 26(b)(1). Any burden imposed on Barkan should be viewed in the context of the burden of the case as a whole. Barkan sought and received an expedited schedule in this case on the premise that this case is similar to the previous litigations. *See* Dkt. 50. Any burden imposed by logging relevant, pre-suit privileged communications is

[1] *See, e.g.*, *Neodron Ltd. v. Panasonic Corp. et al.*, No. 2:20-cv-00241-JRG-RSP (E.D. Tex. Dec. 18, 2020) (Dkt. 39); *Optimum Imaging Techs. LLC v. Canon Inc.*, No. 2:19-cv-00246-JRG (E.D. Tex. Nov. 20, 2019) (Dkt. 41).

[2] *Barkan Wireless IP Holdings, L.P. v. Samsung Elecs. Co. et al.*, No. 2:18-cv-00028-JRG (E.D. Tex. 2018); *Barkan Wireless IP Holdings, L.P. v. CommScope Techs. LLC*, No. 2:19-cv-336-JRG (E.D. Tex. 2019). Further, a different Barkan entity previously sued defendant T-Mobile on different patents in this Court. *Barkan Wireless Technology, LP v. T-Mobile US, Inc., et al.*, No. 2:16-cv-00063 (E.D. Tex. 2016).

substantially outweighed by the admitted efficiencies Barkan has already benefitted from in filing serial litigations. Therefore, Defendants' proposed privilege-log exemption should be adopted.

DATED: May 28, 2021

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing document was filed electronically in compliance with Local Rule CV-5(a). Therefore, this document was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(d) and (e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by email on this 28th day of May 2021.

*/s/ William D. O'Connell*

William D. O'Connell

**CERTIFICATE OF CONFERENCE**

Pursuant to Local Rule CV-7(h), counsel for all parties met and conferred regarding the relief requested above. The parties are agreed on the relief requested with the single exception discussed. The parties met and conferred telephonically and over email to resolve their dispute but were unable to do so.

*/s/ William D. O'Connell*

William D. O'Connell